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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,282	10/16/2006	Luitpold Miller	3468	1876

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Striker Striker & Stenby
103 East Neck Road
Huntington, NY 11743

EXAMINER

SMITH, JASON C

ART UNIT	PAPER NUMBER
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3617

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08/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,282	Applicant(s) MILLER ET AL.	
	Examiner Jason C. Smith	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/22/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 09/22/2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 4-5 and 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** Claims 4-5 and 7-8 recites the limitation "depending on the sliding surface material" in line 2 of all the above mentioned claims. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3617

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-2 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Svensson (6,450,103).** Svensson discloses a guideway carrier (14) with a sliding surface (120) provided with a coating (See Fig. 42, col. 24, lines 36-38) and destined for magnetically levitated vehicles (130), which at least have one sliding skate (158) each destined for setting-down onto said sliding surface (120), with said coating being provided at least in an outer area with an additional material that is compatible to the sliding skate material and which reduces friction and wear; **[claim 2]** characterized in that said additional material contains graphite and/or polytetrafluorethylene (col. 18, lines 15-17). **[claim 12]** A magnetic levitation railway with a guideway comprised of a plurality of guideway carriers (14) provided with sliding surfaces (120) and having at least one magnetically levitated vehicle (130) having at least one sliding skate (158) destined for setting-down onto said sliding surfaces (120), characterized in that said guideway carriers (14) are configured according to claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svensson (6,450,103) in view of Takahashi et al. (2004/0096575).

Svensson discloses the guideway carrier set forth above, but does not disclose one layer made up of polyurethane. However, Takahashi et al. does disclose a magnet with a layer of polyurethane (0173). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a layer made up of polyurethane disclosed in Svensson in view of the teaching of Takahashi et al. The motivation for doing so would have been to provide the sliding surface with corrosion protection. Svensson discloses the claimed invention except for the outer layer comprised of 30 percent by weight to 50 percent by weight of graphite as additional material. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a certain percentage of graphite as the outer layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. The selection of one particular range of percentages of graphite would provide the predictable result of optimizing the properties of the material for a particular application at hand

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Svensson (6,450,103) in view of Takahashi et al. (2004/0096575) in view of

Thompson et al. (2003/0089581). Svensson discloses the claimed invention except for the outer layer comprised of 10 percent by weight to 40 percent by weight of polytetrafluorethylene as additional material. However, Thompson et al. does disclose

an outer layer of polytetrafluorethylene (0057). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a certain percentage of polytetrafluorethylene as the outer layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. The selection of one particular range of percentages of polytetrafluorethylene would provide the predictable result of optimizing the properties of the material for a particular application at hand

8. **Claims 6-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svensson (6,450,103) in view of Takahashi et al. (2004/0096575) in view of Watanabe et al. (2003/0104246).** Svensson discloses the guideway carrier set forth above, but does not disclose one layer made up of epoxy resin. However, Watanabe et al. does disclose a magnet with a layer of epoxy resin (0031). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a layer made up of epoxy resin disclosed in Svensson in view of the teaching of Watanabe et al. The motivation for doing so would have been to provide the sliding surface with corrosion protection. Svensson discloses the claimed invention except for the outer layer comprised of 10 percent by weight to 30 percent by weight of graphite as additional material. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a certain percentage of graphite as the outer layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of

obvious design choice. *In re Leshin*, 125 USPQ 416. The selection of one particular range of percentages of graphite would provide the predictable result of optimizing the properties of the material for a particular application at hand

9. **Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Svensson (6,450,103) in view of Takahashi et al. (2004/0096575) in view of Watanabe et al. (2003/0104246) in view of Thompson et al. (2003/0089581).**

Svensson discloses the claimed invention except for the outer layer comprised of 10 percent by weight to 40 percent by weight of polytetrafluorethylene as additional material. However, Thompson et al. does disclose an outer layer of polytetrafluorethylene (0057). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a certain percentage of polytetrafluorethylene as the outer layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. The selection of one particular range of percentages of polytetrafluorethylene would provide the predictable result of optimizing the properties of the material for a particular application at hand

10. **Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Svensson (6,450,103) in view of Takahashi et al. (2004/0096575) in view of Watanabe et al. (2003/0104246) in view of Tozoni (5,140,208).** Svensson discloses the guideway carrier set forth above, but does not disclose a layer made up of steel. However, Tozoni does disclose a steel surface (1). At the time of the invention, it would

have been obvious to a person of ordinary skill in the art to provide a steel surface disclosed in Svensson in view of the teaching of Tozoni. The motivation for doing so would have been to provide a rigid rail that can support a guideway carrier.

11. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Svensson (6,450,103).** Svensson discloses the claimed invention except for the maximum film thickness of 1 mm. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a maximum 1 mm thickness, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. The selection of one particular value of maximum thickness would provide the predictable result of optimizing the properties of the material for a particular application at hand.

12. **Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Svensson (6,450,103) in view of Arai et al. (2004/0144960).** Svensson discloses the sliding skates set forth above, but does not disclose them composed of carbon fiber enriched with SiC. However, Arai et al. does disclose the carbon fiber-reinforced carbon enriched with SiC. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide the carbon fiber-reinforced carbon enriched with SiC disclosed in Svensson in view of the teaching of Arai et al. The motivation for doing so would have been to provide the sliding skate that would be able to handle the friction energies that are induced when the vehicle is sliding on the surface.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason C. Smith whose telephone number is (571) 270-5225. The examiner can normally be reached on M- F, 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Joseph Morano/
Supervisory Patent Examiner, Art Unit 3617

/Jason C Smith/
Examiner, Art Unit 3617

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